

REMARKS

I. Claims

The following arguments are responsive to the Office action dated October 25, 2007. Claims 7, 9-11, 13-17 and 21-23 were pending in the above application. By this paper, claim 21 has been amended. Method claims 22 and 23 have been withdrawn. New claims 24 and 25 have been added. The new claims have features that are disclosed in the specification but are not shown in the prior art; they find support in the specification on pages 8 to 10, and also in Figures 4. Upon entry of this Amendment E, claims 7, 9-11, 13-17, 21, 24 and 25 will be pending in the application.

II. Claims Rejection 35 USC § 112

Applicant requests reconsideration of the rejection of claims 21, 7, 9-11, and 13-17 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 21 has been amended to particularly claim the invention. Claims 7, 9-11, and 13-17 depend from claim 21.

III. Claims Objection

Applicant requests reconsideration of the objection to claim 21. The inadvertent typographical error in the prior response has been corrected.

IV. Rejection of Claims 21, 7, 9-11, 13-14, and 16-17 under 35 USC § 103

Applicant requests reconsideration of the rejection of claims 21, 7, 9-11, 13-14, and 16-17 under 35 USC § 103(a) as being unpatentable over US 5,725,921 (Baecker) in view of US 5,302,428 (Steele).

The present invention relates to a field liner that is locatable on a timber pole for protecting the timber pole against subsoil decay. The field liner is configured as an elongated cylindrical sleeve which is fixed onto the telephone pole by means of an adhesive substance positioned on the outer surface of the sleeve, NOT by heat

shrinking of the sleeve onto the pole. The field liner as defined in Claim 21 includes features that are both novel and not obvious.

The Examiner relies essentially on the disclosure of Baecker and the disclosure of Steele for the obviousness rejections. The applicant submits that the rejections are flawed for the following reasons.

1) Steele refers to a flat sheet for insulating a pipe or wire, requiring it to be wound around the pipe or wire. An adhesive stripe at the free end of the backing layer permits the free end to be adhered to the region of the backing layer overlapped by the end segment of this layer. The sheet is then secured onto the pipe by heat shrinking.

Steele is non-analogous art. Non-analogous art is not available when making obviousness rejections. To be relied upon as a basis for an obviousness rejection, the art must be in the applicant's field of endeavor or be reasonably pertinent to the problem being solved. MPEP 707.07(f). *In re Oertiker*, 977 F.2d 1443. Steele fails as relevant art because there is no reason to refer to pipe and wire insulation for solving a problem related to protecting timber poles, or a problem related to sizing a cylindrical liner. Thus, Steele is not available when making the rejection.

2) Baecker refers to a field liner comprising a sleeve that is heat shrunk onto a pole. The sleeve must thus fit snugly and slidably onto a pole and is then located by heat shrinking, the location of the sleeve on a pole not being associated in any way with the use of an adhesive. Adhesives are not mentioned or alluded to in Baecker.

3). There is no motivation to combine Steele with Baecker because Steele suggests wrapping a flat sheet around a cylinder and fastening the free end with adhesive on the inside surface and Baecker is already a sleeve. Accordingly, there is no reasonable argument for combining the references.

If one were to combine the references, one would obtain a heat shrink "sleeve" made by wrapping a sheet having adhesive as taught in Steele to form a heat

shrinkable sleeve as taught by Baecker. The Examiner must not pick and chose particular features for combination to reconstruct the claims by hindsight but must look at the references as a whole. Because there is no motivation for combining the references, the rejection should be withdrawn.

4). Neither reference taken individual or combined discloses or suggests a "second layer of material . . . provided with a strip of an adhesive substance positioned on the outer surface of the sleeve, which can adhere to an opposing region of the second layer of material when the sleeve is . . . tightly wrapped around the timber pole" as required by Claim 21. The amendment requires the Examiner to consider the "externally thereon" language that previously given no weight. Further, both references disclose sizing the sleeve by heat shrinking rather than by folding a sleeve over and adhesively bonding as required by Claim 21.

V. New Claims

New claims 24 and 25 have been added which are directed to the method of forming the protective cylinder, the elongate sleeve, and its use. These claims expressly distinguish the present invention from the prior art and are supported by the specification at pages 8 to 10 and by Figures 4 as original presented.

VI. Teleconference with the Examiner regarding Steele and the § 103 rejections.

On February 21, 2008, Kofi Adzamli and David E. Crawford, Jr. contacted the Examiner by telephone to discuss the matters raised herein. The merits of the invention were discussed and features that distinguished the current invention from the references cited were pointed out. Applicant's disagreement with Examiner's analysis was explained. Specifically, it was stressed that the Steele reference was non-analogous art since its application is in a different field to solve a different problem, i.e., insulation of metal pipes, and further requires application of heat. Further, the different

ramifications of the use of an adhesive in the current application and in Steele were pointed out.

The Examiner suggested that Claim 21 be further amended to exclude the application of heat and to present arguments consistent with those made during the interview to further distinguish Steele. Accordingly, claims have been amended in response to the pending Office Action as discussed during the telephone interview.

CONCLUSION

In view of the foregoing, applicant respectfully requests the rejections be withdrawn and request allowance of claims 7, 9-11, 13-17, 21, 24 and 25 now pending in this application.

Applicant requests a 2-month extension of time, up to and including March 25, 2008, for responding to the Office Action dated October 25, 2007. The Commissioner is authorized to charge any fees due or underpayment of government fees to Deposit Account No. 19-1345.

Respectfully Submitted,

/Kofi Adzamlil

Kofi Adzamlil, Reg. No. 52,545
SENNIGER POWERS LLP
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400